

Notice of Allowability

Application No.

09/941,782

Applicant(s)

IWAKI ET AL.

Examiner

Art Unit

Peter J. Macchiarolo

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 07/30/2007.
2. ☒ The allowed claim(s) is/are 1-8, 16-30 and 33-36.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 07/30/2007
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Response to Amendment

The reply filed on 06/21/2007 consists of a terminal disclaimer and remarks related to the prior rejection of claims in the Previous Office Action. The above have been entered and considered. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Terminal Disclaimer

The terminal disclaimer filed on 06/21/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USPN 6817915 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 07/30/2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Allowable Subject Matter

Claims 1-8, 16-30, and 33-36 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding independent claims 1, 16 and 21, the prosecution history, especially at the previous Remarks by Applicant (03/13/2007, page 3) clearly indicates the reasons for allowance.

Specifically, Kyogaku fails to motivate or disclose a specific order of steps in the method claims, and consequently, Kyogaku is silent to Applicant's limitation, "wherein the step for providing the potential difference is conducted after the step for heating said polymer film." As per MPEP 2111.01(II), the courts have held that it is improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order. Consequently, no specific order can be ascertained from the disclosure of Kyogaku. Therefore, since Applicant's method does recite a specific order, claims 1, 16, and 21 are allowable over the closest prior art (Kyogaku). The remaining claims are allowable due to their dependency.

The Examiner notes that the information submitted in the IDS filed 07/30/2007, i.e. the European PRC Office Action, rejected the European counterpart of the instant application based on EP-A-0 986 085 ("D1") and JP 09 045236 ("D2"). The Examiner notes that D1 is the European counterpart to USPN 6383047 ("Minami") used in the non-final rejection dated 03/27/2003. Applicant's amendments and remarks filed 07/01/2003, specifically page 11 of the remarks, clearly sets forth reasons why claim 1 is deemed patentable over Minami.

Furthermore, D2 recites similar features of Minami, with the exception of a step for providing a potential difference between the pair of electrode to energize electrically the electro-conductive film after the step for heating the polymer film.

Therefore, the IDS has been considered and the current claims are deemed patentable over the information therein.

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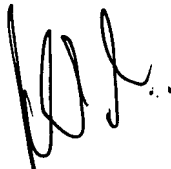
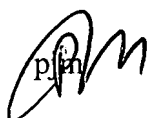
Any comments considered necessary by the Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Macchiarolo whose telephone number is (571) 272-2375. The examiner can normally be reached on 8:30 - 5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimeshkumar D Patel can be reached on (571) 272-2475. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



NIMESHKUMAR D. PATEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800